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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/762,805 | 01/22/2004 | Kiyokazu Ohtaki | 27,540 USA | 5392 |

23307 7590 04/20/2006

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EXAMINER

EDWARDS, ANTHONY Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2835

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/762,805

Applicant(s)

OHTAKI ET AL.

Examiner

Anthony Q. Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,275,810 to Waldmeier. Referring to claim 1, Waldmeier discloses a portable device (Figs. 1 and 2) for receiving an electronic component (8) used for communication by receipt and transmission of wireless signals, the portable device comprising a portable device body (1) for accommodating and enclosing the electronic component (8) therein, the portable device body including an upper case (2) and a lower case (3), each having a cavity (not numbered) and being made of a non-metal material (see col. 3, lines 22-25) for permitting receipt and transmission of wireless signals therethrough for communication with the electronic component enclosed in the portable device body without significantly reducing the receiving and transmission capability of the electronic component, and a holding member (10) for holding peripheral portions of the upper case and the lower case so that the upper case and the lower case are connected to each other with the cavities opposed to each other.

Although Waldmeier does not specifically disclose “permitting receipt and transmission of wireless signals therethrough for communication with the electronic component,” the disclosed structure is capable of performing the recited function. The functional limitation is therefore taught by the prior art. See MPEP 2114.

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Referring to claim 2, Waldmeier discloses a portable device as claimed, wherein the holding member (10) holds the upper case (2) and the lower case (3) so as to surround the portable device body. See Fig. 2.

Referring to claim 3, Waldmeier discloses a portable device as claimed, wherein the upper case (2) includes a first flange (4) extending along the peripheral portion of the thereof, the lower case (3) includes a second flange (4) extending along the peripheral portion of the lower case (see Fig. 3), and the holding member (10) has an inner surface (not numbered) including an engaging groove engaged with the first and second flanges when the upper case and the lower case are connected to each other.

Referring to claim 4, Waldmeier discloses a portable device as claimed, further comprising a seal (6) arranged between the upper and lower case. See Fig. 3 and col. 3, lines 22-25.

Referring to claim 6, Waldmeier discloses a portable device as claimed, wherein the holding member (10) is made of metal and covers only the peripheral portions of the upper case and the lower case when the upper case and lower case are connected to each other. See Fig. 2 and col. 3, lines 53-55.

Referring to claim 7, Waldmeier discloses a portable device as claimed, wherein the holding member (10) includes a plurality of holding member pieces (11/12), wherein adjacent ones of the holding member pieces are in contact with each other at a location separated from the center of a side of the portable device. See Fig. 2, which shows the upper and lower pieces of the holding member contacting each other at the periphery of the device body (1).

Referring to claim 8, Waldmeier discloses a portable device as claimed, wherein the holding member (10) includes two holding member pieces (11/12) that are made of the same material and have the same shape, with the two holding member pieces holding the peripheral portions of the upper case and the lower case. See Fig. 2 and col. 3, lines 52-57.

Referring to claim 11, Waldmeier discloses a portable device as claimed (see the rejections to claims 1 and 7 above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waldmeier.

Waldmeier discloses the device as substantially claimed, including the holding member (10) made of metal that is more rigid than the portable device body (1). See col. 3, lines 53-55.

Although Waldmeier teaches a device body made of glass (col. 3, lines 22-23), as opposed to synthetic resin, the "Background of the Invention" teaches the use plastics in the packing materials in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the device of Waldmeier to include a portable device body made of synthetic resin or plastic to reduce the costs of the device for mass production purposes.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waldmeier as applied to claim 8 above, and further in view of U.S. Patent No. 5,133,451 to Boyd et al. Referring to claim 9, Waldmeier lacks the two holding members (11/12) attached to

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the portable device in directions intersecting a line perpendicular to the plane of the portable device. Boyd et al. teach a protective holder for a coin, wherein the holder includes two holding pieces (32/34) that attach to a portable device (14a) in directions intersecting a line perpendicular to the plane of the portable device (see Fig. 11). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the holding member pieces of Waldmeier, which attached along the upper and lower plane, respectively, of the portable device body, to attach along the side surfaces of the device body, as taught by Boyd et al., since the device of Boyd et al., would reduce the amount of stress applied to the top and bottom of the device body, thereby reducing the likelihood of damaging the electronic component of Waldmeier.

Referring to claim 10, Waldmeier lacks the two holding members (11/12) in the shape of rectangular pieces. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the holding member pieces of Waldmeier to provide the same as rectangular frame-like pieces, since it has been held that mere changes in shape, absent persuasive evidence that the particular configuration of the claimed invention is significant, involves only routine skill in the art. *In re Daily*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the

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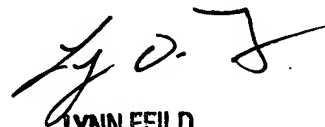
examiner should be directed to Anthony Q. Edwards whose telephone number is 571-272-2042.

The examiner can normally be reached on M-F (7:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 17, 2006
aqe


LYNN FEILD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800